

ESTTA Tracking number: **ESTTA680326**

Filing date: **06/26/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Prometheus Laboratories Inc.
Granted to Date of previous extension	06/28/2015
Address	9410 Carroll Park Drive San Diego, CA 92121 UNITED STATES
Attorney information	Thomas A. Polcyn Thompson Coburn LLP One US Bank Plaza St. Louis, MO 63101 UNITED STATES tpolcyn@thompsoncoburn.com, hal-shathir@thompsoncoburn.com, urogers@thompsoncoburn.com, ipdocket@thompsoncoburn.com

### Applicant Information

Application No	86273120	Publication date	12/30/2014
Opposition Filing Date	06/26/2015	Opposition Period Ends	06/28/2015
International Registration No.	NONE	International Registration Date	NONE
Applicant	NanoTemper Technologies GmbH Floessergasse 4 81369 MÜNCHEN, GERMANY		

### Goods/Services Affected by Opposition

Class 009. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Scientific and optical instruments for measuring chemical, physical, biological and thermal stability of biomolecules; Scientific and optical instruments for measuring and determining the aggregation of biomolecules

### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2121190	Application Date	09/04/1996
Registration Date	12/16/1997	Foreign Priority	NONE

		Date	
Word Mark	PROMETHEUS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1996/09/26 First Use In Commerce: 1996/09/26 reference laboratory services for researchers and clinicians regarding inflammatory bowel diseases		

U.S. Registration No.	2901792	Application Date	10/31/2003
Registration Date	11/09/2004	Foreign Priority Date	NONE
Word Mark	PROMETHEUS		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 005. First use: First Use: 2001/02/28 First Use In Commerce: 2001/02/28 pharmaceutical preparations used for the treatment of gastrointestinal disorders and diseases, inflammatory and autoimmune disorders and diseases, [ cardiovascular disorders and diseases, ] metabolic disorders and diseases, [ infectious disorders and diseases, musculoskeletal disorders and diseases, ] immune modulation and management of side effects associated with renal disorders and cancer; [ diagnostic preparations for clinical or medical laboratory use; and diagnostic reagents for clinical or medical laboratory use ]</p> <p>Class 042. First use: First Use: 1996/09/26 First Use In Commerce: 1996/09/26 Medical laboratory services, namely, laboratory testing, evaluation, and research services; medical laboratory services, namely, disease management and pathology services; and medical laboratory services, namely, providing medical laboratory information to health care providers, managed care providers and patients via global computer networks</p>		

Attachments	notice of opposition.pdf(88852 bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/s/ Thomas A. Polcyn
Name	Thomas A. Polcyn
Date	06/26/2015

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD

Prometheus Laboratories Inc.,	:	
	:	
Opposer,	:	
	:	Opposition No.
v.	:	
	:	U.S. Ser. No. 86/273,120
NanoTemper Technologies GmbH,	:	
	:	Mark: PROMETHEUS
Applicant.	:	

**NOTICE OF OPPOSITION**

Prometheus Laboratories Inc., a California corporation with an address of 9410 Carroll Park Drive, San Diego, California 92121 (“Opposer”), believes it will be damaged by registration of the mark PROMETHEUS for goods in International Class 9, as shown in U.S. Ser. No. 86/273,120 filed by NanoTemper Technologies GmbH, a German GmbH with an address of Floessergasse 4, 81369 München, Germany (“Applicant”), and hereby opposes the application.

As grounds for its opposition, Opposer alleges as follows:

1. Opposer is the exclusive licensee of the mark PROMETHEUS for *reference laboratory services for researchers and clinicians regarding inflammatory bowel diseases; pharmaceutical preparations used for the treatment of gastrointestinal disorders and diseases, inflammatory and autoimmune disorders and diseases, metabolic disorders and diseases, immune modulation and management of side effects associated with renal disorders and cancer; medical laboratory services, namely, laboratory testing, evaluation, and research services; medical laboratory services, namely, disease management and pathology services; and medical laboratory services, namely, providing medical laboratory information to health care*

*providers, managed care providers and patients via global computer networks.* The PROMETHEUS mark is owned by Société des Produits Nestlé S.A. of Vevey, Switzerland (“Nestlé”).

2. In addition to Nestlé’s common law rights in the PROMETHEUS mark, Nestlé owns U.S. Registration Nos. 2121190 and 2901792 for the mark.

3. Opposer, as the exclusive licensee of the PROMETHEUS mark, has promoted and sold goods and services in interstate commerce under the PROMETHEUS mark prior to any alleged use by Applicant of its PROMETHEUS mark and any other alleged priority date relied upon by Applicant. As a result of substantial and extensive sales and promotion, the PROMETHEUS mark has become well known to the trade and public, and therefore acquired significant goodwill and fame.

4. On information and belief, Applicant seeks to register the mark PROMETHEUS for *scientific and optical instruments for measuring chemical, physical, biological and thermal stability of biomolecules; scientific and optical instruments for measuring and determining the aggregation of biomolecules* in International Class 9.

5. Applicant’s mark so resembles the PROMETHEUS mark as to be likely, when used in connection with the applied-for goods in International Classes 9, to cause confusion or to cause mistake or deceive, thus causing damage to Opposer.

ACCORDINGLY, Opposer respectfully requests that this opposition be sustained and that registration of the PROMETHEUS mark be denied.

Respectfully submitted,

/s/ Thomas A. Polcyn

Thomas A. Polcyn

Hadi S. Al-Shathir

THOMPSON COBURN LLP

One US Bank Plaza

St. Louis, Missouri 63101

(314) 552-6000

[tpolcyn@thompsoncoburn.com](mailto:tpolcyn@thompsoncoburn.com)

[hal-shathir@thompsoncoburn.com](mailto:hal-shathir@thompsoncoburn.com)

[ipdocket@thompsoncoburn.com](mailto:ipdocket@thompsoncoburn.com)

Attorneys for Opposer Prometheus Laboratories Inc.

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing has been served upon the following via first-class mail, postage prepaid, on this 26th day of June 2015:

Anne Hiaring Hocking  
Hiaring & Smith, LLP  
101 Lucas Valley Road, Suite 300  
San Rafael, California 94903-1795

/s/ Thomas A. Polcyn